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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,787	09/26/2001	Preeti Lal	PF-0356-3 DIV	5251

7590

01/02/2002

INCYTE GENOMICS, INC.  
PATENT DEPARTMENT  
3160 Porter Drive  
Palo Alto, CA 94304

EXAMINER
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SLOBODYANSKY, ELIZABETH

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 01/02/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/840,787

Applicant(s)

LAL ET AL.

Examiner

Elizabeth Slobodyansky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

This application is a divisional of 09/518,865 now abandoned.

Claims 1-20 are pending.

### **Election/Restriction**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- 1-49. Claims 1 and 15-17 (in part), drawn to a protein of SEQ ID NOs: 1-49, a composition comprising a polypeptide and a method of using a protein for screening, classified in class 436, subclass 86, wherein each Group is respectively drawn to a single protein having a specific SEQ ID NO.
- 50-98. Claims 2-14 (in part), drawn to a polynucleotide of SEQ ID NOs: 50-98, a composition comprising thereof, a vector containing it, a host cell transformed with the same, a method of making a protein using said cell and methods of use of a polynucleotide, classified in class 435, subclass 6, wherein each Group is respectively drawn to a single polynucleotide having a specific SEQ ID NO.
- 99-147. Claims 18-20(in part), drawn to an antibody against a protein of SEQ ID NOs: 1-49, a method of making thereof and a method of use thereof, classified in class 530, subclass 387.1, wherein each Group is

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respectively drawn to an antibody against a single protein having a specific SEQ ID NO.

The inventions are distinct, each from the other because of the following reasons:

Inventions (1-49), (50-98) and (99-147) are patentably distinct because a protein, a DNA and an antibody, are different substances each with its own chemical structure and function, and they have different utilities. The DNA molecules of inventions 50-98 are not limited in use to the production of a protein of inventions 1-49 and can be used as hybridization probes, and a protein of inventions 1-49 can be obtained by a materially different method such as by the biochemical purification or chemical synthesis.

Inventions 1-49 are patentably distinct because they are directed to materially different products and methods of use thereof. A protein having a specific sequence set forth in any of SEQ ID NOs: 1-49 is a distinct compound with its own chemical structure and function, and it has a specific utility.

Inventions 50-98 are patentably distinct because they are directed to materially different products and methods of use thereof. A DNA having a specific sequence set forth in any of SEQ ID NOs: 50-98 is a distinct compound with its own chemical structure and function, and it has a specific utility.

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Inventions 99-147 are patentably distinct because they are directed to materially different products and methods of use thereof. An antibody against a protein having a specific sequence set forth in any of SEQ ID NOs: 1-49 is a distinct compound with its own chemical structure and function, and it binds specifically to a single protein.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their divergent subject matter, fall into different statutory classes of invention, and are separately classified and searched, restriction for examination purposes as indicated is proper.

A telephone call was made to Dr. David Streeter on December 10, 2001 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

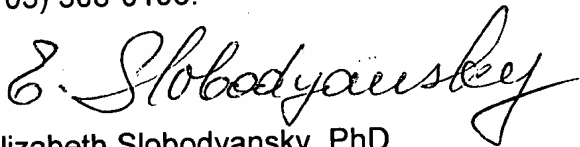
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remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Slobodyansky whose telephone number is (703) 306-3222. The examiner can normally be reached Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX phone number for Technology Center 1600 is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Center receptionist whose telephone number is (703) 308-0196.



Elizabeth Slobodyansky, PhD  
Primary Examiner

December 14, 2001